
In the Supreme Court of the United States
OCTOBER TERM, 1941.

No. 332

THE WILLIAMS MANUFACTURING COMPANY,
Petitioner,

vs.

UNITED SHOE MACHINERY CORPORATION,
Respondent.

PETITION FOR WRIT OF CERTIORARI
To the United States Circuit Court of Appeals
For the Sixth Circuit, and
BRIEF IN SUPPORT OF PETITION.

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To the United States Circuit Court of Appeals

For the Sixth Circuit.

*To the Honorable the Chief Justice of the
United States, and the Associate Justices
of the Supreme Court of the United States:*

Your petitioner, The Williams Manufacturing Company, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Sixth Circuit to review the judgment of that court entered on June 25, 1941.

SUMMARY AND SHORT STATEMENT.

The issue here is the extent of the right to repatent an expired monopoly affecting the entire shoe industry.

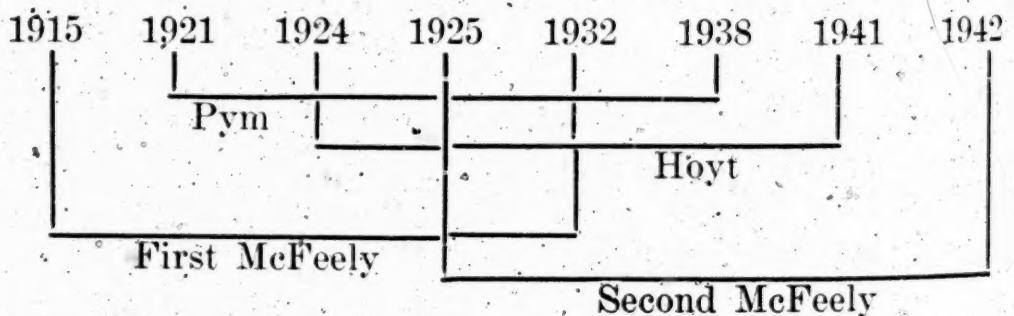
Petitioner was defendant in the District Court, where the respondent prevailed on both patents in suit, the District Court holding the two patents in suit valid and infringed. The Circuit Court of Appeals for the Sixth Circuit reversed the District Court, in part, holding the McFeely patent No. 1,558,737, valid and infringed and the Hoyt patent No. 1,508,394, invalid. Judge Elwood Hamilton of that Court dissented. The primary issue in both courts was the

extension of monopoly by the respondent, the United Shoe Machinery Corporation, in repatenting old expired combinations of its expired patents in new patents in which adjustments, old *per se* in the art, were substituted in the old combination and were reclaimed in broad combinations with the old basic machine covered by respondent's own expired patents.

This extension of monopoly was effected in this manner. The Bill of Complaint was originally founded upon three patents: Pym patent No. 1,368,968, of February 15, 1921, expiring February 15, 1938, covering bed lasters without the superimposed automatic tackers; the second¹ McFeely patent No. 1,558,737, granted October 27, 1925, expiring October 27, 1942, covering bed lasters in combination with automatic tackers; and Hoyt patent No. 1,508,394, granted September 16, 1924, expiring September 16, 1941, for another improved form of combined bed laster and automatic tackers. Respondent withdrew its suit on the expired Pym patent before trial.

The second McFeely patent in suit was abandoned by its owner, the United Shoe Machinery Corporation, in the Patent Office on the 15th day of July, 1921, and renewed on the 24th day of May, 1922. If it had not been so abandoned, it would have issued and now be expired.

The pattern for the extension of monopoly by overlapping patents on heel seat lasting machines of the Respondent is shown in the following diagram of dates of issue and expiration of patents:



¹ The first McFeely patent No. 1,129,881 is the primary anticipatory reference whose expired monopoly is repatented by the second McFeely patent No. 1,558,737 in suit.

The United Shoe Machinery Corporation, respondent, owned the principal prior patent, the first McFeely patent No. 1,129,881, issued March 2, 1915, expiring March 2, 1932. This patent covered the complete combination of a bed laster and automatic tackers for the heel seat lasting of shoes. It was built by the United Shoe Machinery Corporation and placed in the plant of the Victor Shoe Company, where it operated under commercial conditions successfully, lasting shoes of various sizes, and was acclaimed before the United States Patent Office, by affidavit from the employees of the United Shoe Machinery Corporation, as a pioneer advance, successful commercially, and the first McFeely patent was granted accordingly. (R. Vol. 1, pp. 471-6, Def. Exh. H-2.)

In the District Court the Respondent, United Shoe Machinery Corporation, took the position that the machine of the first McFeely patent had never been built and was not a commercial machine. (R. Vol. 1, p. 396.) This proof was promptly challenged by the petitioner who produced, before the decision of the District Court and before argument, the certified copy of the filewrapper of the first McFeely patent, containing affidavits of respondent's employees, filed in the United States Patent Office, that the machine of the first McFeely patent had been successfully and commercially used on various sizes of shoes. (Opinion of Court of Appeals, R. 509-10, Vol. 1.) The District Court rejected this evidence as being offered too late, and found that the McFeely patent in suit was the first commercially successful heel seat lasting machine. (R. Vol. 1, pp. 478-9.) The Circuit Court of Appeals for the Sixth Circuit disapproved this course of the District Court and gave this evidence consideration, saying: "Although the machine successfully lasted shoes of specific sizes, it proved incapable of operating satisfactorily upon a range of sizes large enough to adapt it for commercial operation in the ordinary shoe factory." (R. 510, Vol. 1.)

Respondent has placed 1200 machines with shoe manufacturers. The issue of the control by a patent of these expensive and complicated machines, which constitutes one of the major expenses of making shoes, is of great public interest. (R. Vol. 1, p. 124, A. 6; Ib. 399; Ib. 483.)

The differences claimed by respondent as to the second McFeely patent over the first to enable the second machine to operate on a greater range of sizes are:

(a) Means for preliminary **adjustment** of the wipers or tackers to accommodate a greater variety of sizes of shoes. (Old in prior art patents, R. Vol. 2, pp. 114, 122, 134, 140, 222, 238, 240.)

(b) Sliding heel band **adjustment** for the in and out movement of the shoe. (Old in prior art patents, R. Vol. 2, pp. 114, 122, 134, 172, 384, 440.)

(c) Means for **adjusting** the amount of vertical movement of the hold-down for the adjustment of the height of the shoe in the machine. (Old in prior art patents, R. Vol. 2, pp. 232, 440.)

These three adjustments are old **per se** in this art and have been used in numerous heel seat lasting machines shown in the above expired patents.

The Decision of the District Court.

The District Court held both patents valid and infringed, and that the improvements and adjustments of the second McFeely, included in the claims to the broad combinations, entitled respondent to repatent the entire combination of bed laster and automatic tackers, because these improvements-adjustments enabled the second McFeely patent to operate upon a wider range of sizes of shoes and, therefore, made the second McFeely construction with the three adjustments a more commercially successful machine. (R. 483, Vol. 1.)

The Decision of the Court of Appeals.

The Circuit Court of Appeals followed the decision of the District Court in sustaining the second McFeely patent as valid and infringed. It failed to follow the doctrine on extension of monopoly as laid down by this Court in *Bassick v. Hollingshead*, 298 U. S. 415, and *Lincoln v. Stewart Warner*, 303 U. S. 545. It reversed the District Court as to the Hoyt patent. Judge Elwood Hamilton of the Circuit Court of Appeals dissented without a dissenting opinion.

REASONS RELIED UPON FOR THE ALLOWANCE OF THE WRIT.

Petitioner believes that writ of certiorari should be granted in this case for the following reasons and accordingly the discretionary power of this Court is invoked:

Extension of Expired Monopoly.

1. That the Circuit Court of Appeals for the Sixth Circuit, in holding the second McFeely patent No. 1,558,737, valid over the prior invention and patent of McFeely No. 1,129,881, has rendered a decision in conflict with the principles of the decisions of this Court in *Bassick v. Hollingshead*, 298 U. S. 415 and *Lincoln v. Stewart Warner*, 303 U. S. 545, prohibiting the extension of monopoly of an expired patent by the substitution of mechanical details, already old in the art, in a second patent in an identical basic mechanism as in the first expired patent,—a mere substitution or improvement of parts in an old combination. The failure to follow established rules of this Court is ground for certiorari. *Cities Service v. Dunlap*, 308 U. S. 208.

Aggregation: Extension of Monopoly.

2. That the Circuit Court of Appeals for the Sixth Circuit in upholding the validity of McFeely patent No. 1,558,737, which merely aggregates old adjusting features with an old combination, has rendered a decision in conflict with the principles applied in such cases as *Grinnell v. Johnson Co.*, 247 U. S. 426.

Commercial Success of Prior Art Unnecessary for Anticipation.

3. That the Circuit Court of Appeals for the Sixth Circuit in upholding the validity of McFeely patent No. 1,558,737 has rendered a decision in conflict with the decision of this Court and the principles therein as applied in such cases as *Smith v. James* and *Smith v. Hall*, 301 U. S. 216, to the effect that a prior machine constitutes anticipation, even though it is commercially unsuccessful and is incapable of operating to the fullest range of capacity to adapt it for commercial operation. The decision of the Court of Appeals herein is in conflict with the principles announced in the decision of this Court in *Smith v. James, supra*, in which the Hastings prior use was held to anticipate the Smith patent notwithstanding the Hastings prior use did not meet with commercial success.

Diversity of Opinion Below: No Other Opportunity to Present the Case.

4. That the McFeely patent in suit will expire in October, 1942, and there is no opportunity of securing a diversity of opinion with other Circuits, but there is a diversity of opinion in the United States Circuit Court of Appeals for the Sixth Circuit, his Honor, Judge Elwood Hamilton, having dissented from the majority opinion.

Public Importance.

5. That this case involves the payment of royalties or rentals to United Shoe Machinery Corporation by shoe manufacturers on more than 1200 machines and is, therefore, one of great public importance to the public and hundreds of shoe manufacturers upon whom the respondent levies tribute through royalties or rentals. The principle of extension of monopoly by the method employed in drafting these patents, if not corrected, will extend indefinitely the monopoly of patents of this class over the shoe industry.

PRAYER.

Wherefore, your petitioner respectfully prays that writ of certiorari be issued to the Circuit Court of Appeals for the Sixth Circuit to the end that this cause may be reviewed and determined by this Court in accordance with the principles of law heretofore announced by it; that the decree of the Circuit Court of Appeals for the Sixth Circuit be reversed as to the finding of validity of McFeely patent No. 1,558,737 of October 27, 1925; and that the petitioner be granted such other and further relief as may be proper.

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BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

THE OPINIONS OF THE COURTS BELOW.

The opinion of the District Court is found on pages 477 to 485 Vol. 1 of the record. The opinion of the Circuit Court of Appeals (Circuit Judges Simons, Hamilton and Martin, Judge Simons writing and Judge Hamilton, dissenting) appears at pages 502 to 513, Vol. 1, of the record. This opinion of the Circuit Court of Appeals for the Sixth Circuit is not yet reported.

JURISDICTION.

The decree of the Circuit Court of Appeals was entered June 25, 1941 (R. 501, Vol. 1) and the opinion was filed June 27, 1941 (Ib. 502). The statute giving jurisdiction is 240-A of the Judicial Code (28 U. S. Code, Sec. 347). The judgment was rendered in a suit in equity brought under the patent statutes to determine the validity of Letters Patent of invention.

The cases believed to sustain jurisdiction are:

- Cities Service v. Dunlap*, 308 U. S. 208;
- Scriber Co. v. Cleveland Trust*, 305 U. S. 47;
- Mackay Radio & Telegraph Co. v. Radio Corp.*, 306 U. S. 86;
- Bassick v. Hollingshead*, 298 U. S. 415;
- Lincoln v. Stewart Warner Corp.*, 303 U. S. 545;
- Leitch Mfg. Co. v. Barber*, 302 U. S. 458;
- Altoona Public v. American Tri-Ergon*, 294 U. S. 477;
- Carbice v. American Patents*, 283 U. S. 27;
- DeForest Radio v. General Electric*, 283 U. S. 664.

STATEMENT OF THE CASE.

The foregoing petition contains a summary of the material facts necessary to an understanding of the reasons relied upon for the allowance of the writ as well as the statement of the questions involved in the case.

SPECIFICATION OF ERRORS.

The specification of errors herein relied upon are those reasons set forth in the petition as grounds for its allowance.

THE ISSUE.

The primary issue is **extension of monopoly** by repatenting an old combination to redominate a trade for another seventeen years, contrary to the principles announced by this Court in *Bassick v. Hollingshead*, 298 U. S. 415, and *Lincoln v. Stewart Warner Corp.*, 303 U. S. 545.

SUMMARY OF THE ARGUMENT.

The argument is summarized in the "Reasons Relied Upon For The Allowance of The Writ" found in the petition. Briefly the argument is:

1. The decision of the Court of Appeals herein conflicts with the decisions of this Court in *Bassick v. Hollingshead*, 298 U. S. 415 and *Lincoln v. Stewart Warner*, 303 U. S. 545. The Court of Appeals declined to apply the principle announced by this Court in these cases to the effect that an old combination cannot be repatented by improving elements of the old combination. Respondent herein merely made adjustable certain parts of the old combination, which in no way affects the operation of the old combination. The adjustments are made before the old combination operates and only when a different size shoe is to be lasted, which is not often. Such conflict is ground for granting certiorari. *Cities Service v. Dunlap*, 308 U. S. 208.

2. The decision of the Court of Appeals is contrary to this Court's decision in *Grinnell v. Johnson*, 247 U. S. 426, against aggregating old adjusting features with an old combination.

3. The decision of the Court of Appeals in sustaining the second McFeely patent on the ground of commercial success is contrary to the decisions of this Court in *Smith v. James* and *Smith v. Hall*, 301 U. S. 216 to the effect that a prior machine is an anticipation even though it is not commercially successful. See also *Hildreth v. Mastoras*, 257 U. S. 27, 34.

4. The McFeely patent will expire in October, 1942 and there is no opportunity of securing a diversity of opinion in other Circuits. There is diversity of opinion among the Judges of the Court of Appeals in this case, because Judge Elwood Hamilton dissented.

5. There is great public importance in this case because Respondent has licensed 1200 of its machines. This is of great public importance because the tribute levied upon the manufacturers by Respondent is passed on to the large number of purchasers of shoes.

A R G U M E N T.

POINT I.

The McFeely patents are substantially identical except for three improved adjustments, themselves old in this art: the second McFeely patent in suit No. 1,558,737 has re-patented an old combination set forth and claimed in the first McFeely patent No. 1,129,881 and other patents of respondent.

The two McFeely patents, the expired patent No. 1,129,881 and the McFeely patent in suit No. 1,558,737, as will be seen from an examination of their drawings and specifications, are **substantially identical in construction, operation and result**. (R. Vol. 2, 266, 2.) The second McFeely patent says :

“This invention relates to lasting machines for use in the manufacture of boots and shoes, and is herein illustrated in its application to a machine for lasting

the heel ends, or the heel seats, of shoes, the drawings showing a machine of the same general type as that illustrated in United States Letters Patent No. 1,129,881 granted upon my application on March 2, 1915, in which type of machine it is one of the objects of the invention to effect improvements." (p. 1, ll. 12-22.)

The only differences claimed by respondent are the additions in the second McFeely patent to the first McFeely patent to make (a) the wipers or tackers, (b) the heel band, and (c) the hold-down adjustable so as to give the second McFeely patent greater flexibility in lasting a greater variety of sizes of shoes. (R. 420, Finding 29, Ib. 481, Ib. 511-12, Vol. 1.)

The District Court, whose findings were affirmed by the Circuit Court of Appeals, held:

"* * * that while the McFeely patent in suit No. 1,558,737, embraces many elements of the McFeely patent No. 1,129,881, the earlier McFeely patent lacked, so far as it relates to Claims 6 and 85, certain elements which prevented it from being commercially successful; that is to say, among others, it would not permit of a successful operation upon a range of shoe sizes; the operation of the tackers and wipers could not be controlled with accuracy; or in other words, adjusted as are the tackers and wipers in the machine covered by the patent in suit; and also, immediately before the tacking movement the wipers would be retracted partly to permit of the tacking and in so doing have a tendency to pull the upper from the insole, which would tend in some instances to and in many operations did make an imperfect job, if not damage the shoe. This was overcome in the machine covered by the patent in suit by the wipers moving in toward the shoe, holding the upper in place rather than pulling the upper away from the last, prior to the tacking as in the earlier McFeely patent." (R. Vol. 1, p. 483.)

The Court of Appeals said as to the first McFeely patent: "Although the machine successfully lasted shoes of

specific sizes, it proved incapable of operating satisfactorily upon a range of sizes large enough to adapt it for commercial operation in the ordinary shoe factory." (R. 510, Vol. 1.)

The additions comprised, therefore, these three adjustments to make the second McFeely a more commercial machine. If they were novel, they should have been patented *per se*. The additions themselves, as hereinafter pointed out, were old in this art, used in similar combinations for heel seat lasting, and were substitutions within the skill of the art open to the public and no longer susceptible to exclusive monopoly by this respondent, whose patents thereon had expired. (R. Vol. 2, pp. 280, 440.)

A patentee cannot, by improving elements of an old combination, whose construction and operation is otherwise unchanged, in effect repatent the old combination for another seventeen years by reclaiming it with the improved elements substituted for the old elements or in improvement thereof. *Bassick v. Hollingshead*, 298 U. S. 415 and *Lincoln v. Stewart Warner Corp.*, 303 U. S. 545.

The McFeely patents relate to an automatic heel seat lasting machine for the purpose of "heel seat lasting," i.e., the turning over of leather of a shoe upper on the bottom of the insole and the tacking of the leather against such insole before the application of the heel to the shoe. Heel seat lasting is an accomplishment practiced by automatic and semi-automatic machinery in this art of more than sixty years. (Copeland 244, 714, etc., R. 114, Vol. 2.) The result of heel seat lasting of shoes of different sizes was accomplished by first McFeely patent No. 1,129,881, the Court of Appeals below finding that it "successfully lasted shoes of specific sizes." (R. 510, Vol. 1.)

According to respondent's claim as to the difference between the first McFeely and the second McFeely patents, there are **three adjustments found in the second McFeely**

not found in the first McFeely. The result of these adjustments was to make it possible to handle a greater number of different sizes and shapes of shoes, according to respondent's claim. These adjustments were first that of the heel band by which it was connected positively for fore and aft movement. This two-way, in and out adjustment *per se* in the second patent, was substituted for adjustable rubber band supports that moved the heel band in one direction only in the first McFeely patent. (Opinion of Circuit Court of Appeals, R. 511, Vol. 1.) The two-way adjustment of a heel band in the first McFeely was an old characteristic in the art as shown in the patents to Copeland, No. 244,714; Lombard, No. 542,445; Eaton, No. 596,323; Brock, No. 601,935; Plant, No. 958,280; Brock, No. 1,118,616; Pym, No. 1,368,968 and Keyes, No. 1,023,854, see Figure 10. (R. Vol. 2, pp. 114, 122, 134, 140, 222, 238, 440.)

The second adjustment was a predetermined one for the wipers to initially position them to accommodate different sizes of shoes. (Opinion of Circuit Court of Appeals, R. 511, Vol. 1.) This also was an adjustment common in this art in such patents as Pym, No. 1,368,968; Copeland, No. 244,714; Lombard, No. 524,445; Eaton, No. 596,323; Brock, No. 1,118,616 and Snow, No. 946,708. (R. Vol. 2, pp. 440, 114, 122, 134, 384, 172.)

The third adjustment (opinion of Circuit Court of Appeals, R. 511, Vol. 1), was the vertical movement of the hold-down, which also was, *per se*, old in respondent's expired Pym patent No. 1,368,968, formerly in this suit, and Keyes, No. 1,023,854. (R. Vol. 2, pp. 232, 440.)

In the present case the Court of Appeals of the Sixth Circuit found that these adjustments produced a new result, meaning apparently, "an improved" result, because, of course, the result of heel seat lasting was a very old one and had been for the last sixty years. Copeland, No. 244,714 and subsequent patents (R. Vol. 2, p. 114.)

The Court of Appeals below said:

"It is true that many of the features of the claims are old and that an organization, including wipers and tackers, was shown in somewhat primitive form in Copeland. It is also true that adjustability of elements, though not in the form shown in the first McFeely patent, is added by the patent in suit to the McFeely type laster, and that mere adjustability by common mechanical expedients may not, of itself, denote the presence of the quality of invention and merit the issue of a patent." (R. 511, Vol. 1.)

The adjustable features in the second McFeely do not in any way modify the lasting operation. **The adjustments are made by hand before the lasting operation starts.** (R. Vol. 1, p. 47, A. 3, Ib. 409-10, Ib. 69, A. 17, Ib. 368, XA: 312-315, Ib. 369, XA. 319.) The result of the lasting operation is exactly the same as in the first expired McFeely patent and in other prior art patents. (R. 15, Vol. 2, lines 19-23, p. 3, patent 1,558,737; Rec. 129, Vol. 2, XA. 1-15; Ib. 298-9; Ib. 300-5; Ib. 314-16; Ib. 318-321; Ib. 362-3, XA. 263-274; Ib. 394-5; Ib. 420.)

Petitioner's position is that the claims of the second McFeeley patent go to the old combination, which is expired, and include these adjustments as a part of the old combination in substitution for other adjusting mechanism in the first McFeely patent, thereby **in effect repatenting the old combination by reclaiming it with the improved elements substituted for the old elements**, as for instance, substituting the two-way adjusting mechanism for the heel band in the first McFeely patent for its heel band with the rubber cord supports.

The evil of the system of granting and sustaining patents for a repatented combination from which there has been removed a more or less uneconomical element and substituting an old element which is more effective, permits an endless extension of monopoly, and a permutation of the possible combinations so that the patents secured are

endless in number and never restricted in scope. Respondent in the case of the Hoyt patent in suit was held guilty of such extension of monopoly by the Circuit Court of Appeals herein. (R. 512-13, Vol. 1.) This practice enables an energetic Patent Department of a great corporation like that of respondent, through the sheer mass of such patents so secured by repatenting old monopolies, to make it impossible for any manufacturer of shoes to do other than to comply by rental of its machines and thereby pay tribute to such patents **without end to the tribute.**

In *Bassick v. Hollingshead*, 298 U. S. 415, this Court held that an old combination could not be repatented by improving one or more of the old elements. This Court said:

"It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler, and a grease cup or pin fitting. First, he contrived an improved pin fitting. This he patented as such (No. 1,307,733.) Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.) He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. (Claims 14 and 15.) **The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts.**" (pp. 424-425.)

The Court of Appeals was reversed.

In *Lincoln v. Stewart Warner*, 303 U. S. 545, this Court also held the patent invalid because the improvement was in one part of an old combination.

“* * * The invention, if any, which Butler made was an improvement in what he styles in his specifications the ‘chuck’ and in his claim a ‘coupling member.’ It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. Butler may have devised a patentable improvement in such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think he did no more than this. As we said of Gullborg in the Rogers case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.⁵ And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.⁶” (pp. 549, 550.)

The Court further said:

“* * * The function of a pump has always been to force a fluid or a grease through a conduit. The fact that this function of the pump is utilized in Butler’s improved form of coupler not only to convey the lubricant to the bearing but to operate the jaws of the chuck does not alter the function of the pump. The invention, if any, lies in the improvement in the coupling device alone.” (p. 551.)

“We conclude that Butler’s effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void.” (p. 552.)

The heel seat laster in the second McFeely patent operates exactly the same as the heel seat laster in the first McFeely heel seat laster. The addition of the ad-

justable features, taken from the old art, does not in any way affect the old heel seat lasting mechanism of the first McFeely patent. The result obtained by both is the same. The adjustments are made solely for the purpose of accommodating different sizes of shoes and are used only when a different size shoe is to be lasted.

McFeely's effort in his second patent, by the use of a combination claim, to extend the monopoly of his invention of an improved form of adjustment (taken from the prior art) to old parts or elements (the first McFeely patent) having no new function when operated in connection with the coupler renders the claims void.

The Court of Appeals erred in not recognizing that the facts in the present case are exactly the same as in the "*Bassick*" and the "*Lincoln*" cases, *supra*; and in not holding the claims invalid because they cover an old combination with adjustments added which do not operate when the heel seat lasting operation is effected, and which operate only when the size of the shoes is to be changed and before any different sized shoe is lasted.

It misapplied the principles laid down by this Court as evidenced by the following statement from its opinion (R. 511, Vol. 1):

"There is here much more than mere improvement in quality or quantity of product due to the independent functioning of an improved element, as in *Bassick v. Hollingshead*, 298 U. S. 415, or *Kodel Elec. Co. v. Warren Clock Co.*, 62 Fed. (2d) 692 (C. C. A. 6)."

We submit that the doctrine against repatenting an old combination by substituting old elements or even adding old elements, **is not limited to the conditions just specified in the above quotation.** This Court's decision prohibits remonopolizing that which has already been dedicated to the public by expiration of a prior patent, whether the latter effort to repatent involves a matter of substitution of elements or additions thereto. To so limit

the doctrine of the *Bassick* and *Lincoln* cases, as did the Court of Appeals below, would make them substantially ineffective to prevent the abuses from extension of monopoly in most cases.

The failure of the Court of Appeals to follow the *Bassick* and *Lincoln* cases is ground for certiorari. This Court granted certiorari in *Cities Service v. Dunlap*, 308 U. S. 208, saying:

"This cause is here in order that we may decide whether the Circuit Court of Appeals wrongly declined to follow the rule of the Texas Courts prescribing how and by whom the facts should be shown where one party to a contest concerning ownership of land claims the legal title as bona fide purchaser."

This Court of Appeals was accordingly reversed because it did not follow the established rule.

POINT II.

Aggregation: Another Form of an Attempt to Repatent Expired Old Combinations.

When an attempt is made to patent a combination of two or more elements or old combinations, it is another form of attempted monopoly extension over what has gone into the public domain. Engineering contributions in the common store of knowledge of an industry **cannot be rededicated to monopoly without the justification of a new function or a new result from the combination**; without such new function or new result it is aggregation and the associated mechanisms still stay within the public domain. Mere improvements in result or economy of greater success cannot revitalize an aggregation into an invention.

All that McFeely did in the second patent was to add to the expired first McFeely patent the prior art adjustments which were old and public property. The operation of the adjustments and the heel seat lasting are not

simultaneous, as in the *Grinnell* case, but are entirely separate and are independent of one another. There is no true cooperation to make a patentable combination. No new and useful result is produced by the second McFeely patent from the "cooperating action of the elements." It follows that the McFeely patent is merely for an aggregation of old combinations and invalid.

In the *Grinnell v. Johnson* case, 247 U. S. 426, this Court said:

"The question is, does this bringing together of old elements accomplishing the purposes stated amount to that combination which is invention within the meaning of the patent law; or does the gearing device, thus applied and used, show only an aggregation of old elements performing well-known functions, producing no novel and useful result entitling the aggregation to the protection of a patent?" (pp. 431-2.)

After quoting from authorities as to aggregation, this Court said:

"Applying the rule thus authoritatively settled by this court, we think no invention is shown in assembling these old elements for the purposes declared. **No new function is 'evolved from this combination'; the new result, so far as one is achieved, is only that which arises from the well-known operation of each one of the elements.**" (p. 433.)

The Court of Appeals of the Sixth Circuit erred in sustaining the second McFeely patent because of additions to the expired first McFeely patent of prior art adjustments to make the machine more versatile and in holding that the rule of this Court against extending a patent monopoly applies only when the improvement is in quantity or quality of the product. This ruling is contrary to *Grinnell v. Johnson, supra*, in which this Court held that convenience, economy and superiority do not make an aggregation patentable. This Court said:

“* * * Phillips may have produced a more convenient and economical mechanism than others who preceded him, but superiority does not make an aggregation patentable. *Specialty Manufacturing Co. v. Fenton Metallic Manufacturing Co., supra.* The assemblage of the old elements, and their operation in the manner indicated, may save time, and the mechanism may meet with a readier sale than other similar devices, but these things may result from mechanical skill and commercial enterprise, and do not necessarily involve invention.” (p. 434.)

In *Specialty Mfg. Co. v. Fenton*, 174 U. S. 492, 498, *supra*, this Court said:

“Hoffman may have succeeded in producing a shelf more convenient and more salable than any which preceded it, but he has done it principally, if not wholly, by the exercise of mechanical skill.”

This Court did not limit the restriction against extending the monopoly by improving one part of an old combination to cases in which the second patent covers a mere improvement in quantity or quality of the product. The true rule as set forth in *Bassick v. Hollingshead*, 298 U. S. 415, is that, although an element is improved in an old construction, the patent is invalid. As this Court said:

“The question is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other Federal Courts.” (p. 425.)

That is exactly what McFeely has done. McFeely took the added adjustments from the prior art. This does not render the combination patentable; the approval of such a course, by the Court of Appeals below, makes this Court's decisions ineffective in applying the applicable rule.

POINT III.

**Commercial Success is not Essential to
Anticipation by a Prior Patent.**

The Court of Appeals below founded its decision on the fact that as between the first McFeely patent and the second, **the second was more successful commercially than the first.** It said that one machine was built in accordance with the first McFeely and:

“Although the machine successfully lasted shoes of specific sizes, it proved incapable of operating satisfactorily upon a range of sizes large enough to adapt it for commercial operation in the ordinary shoe factory.” (R. 510, Vol. 1.)

This we submit is contrary to the doctrine established by this Court in *Smith v. James* and *Smith v. Hall*, 301 U. S. 216, and numerous other cases. Anticipation cannot be decided on the basis of comparative commercial success between the anticipating structure and the structure of the patent in suit. Even though the anticipating patent structure is not commercially successful, it is still an anticipation if it has already disclosed the principles of the invention to the public. Likewise, reliance upon commercial success is an unsafe ground to sustain a broad monopoly, and is only resorted to in cases of doubt; but even then such proof can be no substitution for a lack of invention over the prior art as in this case.

Textile Machine Works v. Louis Hirsch Textile Machines, Inc., 302 U. S. 490-498-499;

Paramount Publix Corp. v. American Tri-Ergon Corp., 294 U. S. 464-474;

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., et al., 294 U. S. 477-486;

DeForest Radio Co. v. General Electric Co., 283 U. S. 664;

Grant v. Walter, 148 U. S. 547-556.

The Court of Appeals founded its decision on the contrary principle to that established by this Court, that is, that even if the anticipating structure operated successfully, while the machine of the patent in suit was more commercially successful, then there could be no anticipation. This Court, in *Smith v. James, supra*, however, held that commercial success is unnecessary. In that case this Court said as to the Hastings prior use:

"It is immaterial that his structure for using the method was neither the best possible nor as skilfully designed or used as that later employed by Smith. *Pickering v. McCullough*, 104 U. S. 310, 319; cf. *Telephone cases*, 126 U. S. 1, 531, 536." (p. 232.)

With reference to the Hastings Brooklyn and Muskogee prior uses, this Court said:

"* * * the fact that both incubators functioned, are convincing evidence that Hastings knew and used in appropriate combination, both in Brooklyn and in Muskogee, the essential elements of the Smith claim." (pp. 232-3.)

"He knew the method and used it in a device capable of employing it. In such circumstances want of commercial success, which the record suggests may have been due to lack of technical and business skill, is not an indication that there was no prior use." (p. 233.)

The first McFeely patent lasted heels exactly the same as the second McFeely. The only difference was that the second McFeely could handle more sizes than the first McFeely, but the lasting operation was identical in both. It is, of course, immaterial that the second McFeely did a more perfect job. The first McFeely, therefore, is an anticipation of the second McFeely.

In *Hildreth v. Mastoras*, 257 U. S. 27, 34, this Court said:

"It is not necessary, in order to sustain a generic patent, to show that the device is a commercial success. The machine patented may be imperfect in its opera-

tion; but if it embodies the generic principle, and works, that is, if it actually and mechanically performs, though only in a crude way, the important function by which it makes the substantial change claimed for it in the art, it is enough."

As between the first McFeely and the second McFeely the first is generic and the Court of Appeals found that it "successfully lasted shoes" but not in as wide a range of commercial sizes.

Therefore, the Court of Appeals erred in disregarding this Court's decision to the effect that commercial success is not a necessary factor to make an anticipating machine.

POINT IV.

Diversity of Opinion.

The second McFeely patent will expire in October, 1942.

There has been no opportunity and none is likely to present itself, to secure diversity of opinion on the validity of the McFeely patent No. 1,558,737. Judge Elwood Hamilton, however, dissented from the opinion of the Circuit Court of Appeals for the Sixth Circuit without writing an opinion.

While there is no conflict of decision between the Circuits, as to the McFeely patent in suit, but only a conflict of opinion between the Judges of the Sixth Circuit Court of Appeals, yet the decision below conflicts with principles established by this Court, and for that reason certiorari is sought. *Ansaldo v. Rheinstrom*, 294 U. S. 494; *U. S. v. Constantine*, 296 U. S. 287, 290; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U. S. 464; *Altoona Theatres v. American Tri-Ergon Corporation*, 294 U. S. 477; *Mechanics v. Culhane*, 299 U. S. 51, 53; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 305 U. S. 47-61; *Cities Service v. Dunlap*, 308 U. S. 208; *Mackay Radio v. Radio Corp.*, 306 U. S. 86; *Bassick v. Hollingshead*, 298 U. S.

415; *Lincoln v. Stewart Warner Corp.*, 303 U. S. 545; *Leitch v. Barber*, 302 U. S. 458; *Carbice v. American Patents*, 283 U. S. 27; *DeForest Radio v. General Electric*, 283 U. S. 664.

POINT V.

Public Importance.

1200 of the machines involved in the McFeely patents, are under lease by the respondent. (Vol. 1, R. 399, 483.) Automatic heel seat lasting is one of the fundamental features of shoe making. The tribute upon the shoe industry which must inevitably be reflected in the cost of shoes, thereby very gravely affects the public interest. Only one with the clearest title to monopoly should have it under such circumstances.

Respondent already stands condemned by the Circuit Court of Appeals for the Sixth Circuit for attempting to extend its monopoly on this same mechanism in the Hoyt patent in suit No. 1,508,394. (R. 513, Vol. 1.) The action of respondent in abandoning the application in the United States Patent Office of the second McFeely patent in suit for ten months and then reviving it, is another phase of what was heretofore the prevalent practice of extending a monopoly. This Court stopped one phase of such a practice in *Bassick v. Hollingshead*, 298 U. S. 415, and *Lincoln v. Stewart Warner Corp.*, 303 U. S. 545. Congress has recently rendered illegal the practice of extending monopoly by abandonment and revival. U. S. C. A., Title 35, Sec. 41, provides that a patent shall be withheld unless the final fee is paid within six months after the allowance of the application except that the Commissioner in his discretion may receive the final fee during the year following the six month period.

The large number of patents of this respondent, many of which are in this record, make it essential to the public interest that this vast monopoly over the shoe industry be limited strictly in accordance with the principles announced by this Court.

We earnestly submit that this Court should order in this case to prevent this serious departure from the principles of the law announced by it.

Respectfully submitted,

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